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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,576	08/04/2000	Larry W. Blake	TEKIA.002A	1860

20995 7590 10/11/2002

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EXAMINER

BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 10/11/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/631,576

Applicant(s)

BLAKE, LARRY W. 

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40,41 and 46-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40,41 and 46-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention IV (claims 40 and 41) in Paper No. 6 is acknowledged.
2. Claims 1-39 and 42-45 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Drawings

3. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

4. The abstract of the disclosure is objected to because:
 - a. The title of the abstract does not match the title of the specification ("V"-shaped phakic IOL instead of "L"-shaped phakic IOL)
 - b. The abstract should be generally limited to a single paragraph.Correction is required. See MPEP § 608.01(b).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application (see 37 CFR 1.130(b)).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 40, 41, 46-52, 56-59, 61, 67, 75, and 76 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-7, 16, 17, 19, 20, 22-24, 26, 27, and 36 of copending Application No. 10/056,971.

Although the conflicting claims are not identical, they are not patentably distinct from each other since the referenced copending application and the instant application are claiming common subject matter, as follows: an attachment for a two-part (optic + haptic) IOL comprising a cleat(s) and an eyelet(s).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 40, 41, and 46-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- a. Regarding claim 40, from the claim language it is not clear on which part of the two-part IOL is the eyelet located. This renders the claim vague and indefinite. Claims 41 and 46-76 inherit this problem.
- b. Regarding claim 41, it depends on a non-elected claim (claim 30).
- c. Regarding claim 51, that the haptic "further comprises at least one more attachment" (line 2) lacks antecedent basis.
- d. Regarding claim 55, the phrase "to be rotationally fit" (line 2) is confusing and renders the claim vague and indefinite.
- e. Regarding claim 66, the phrase "and the like" (line 3) is indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable.
- f. Regarding claim 69, that the lower modulus material "is extended toward the foot of said haptic" (line 2) is confusing and renders the claim vague and indefinite.
- g. Claim 69 recites the limitation "the eye tissue" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 40, 41, 46, 47, 49-52, 56, 67, 73, and 74 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kelman (US 4,268,921 A; cited in Applicant's IDS). As seen in Figures 2 and 3, Kelman discloses an attachment for a two-part IOL comprising a cleat (see free end 42 of support member 32) on one part of said IOL and an eyelet (see recess 34 of lens body 12) allowing said cleat to firmly attach on said second part of said two-part IOL (see also Figure 4; column 3, lines 3-7, lines 11-15, and lines 32-38; column 4, lines 22-36; see entire document).

11. Claims 40, 46, 56, 67, 73, 75, and 76 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kelman (US 4,608,049 A; cited in Applicant's IDS). As seen in Figures 7 and 8, Kelman discloses an attachment for a two-part IOL comprising a cleat(s) on one part of said IOL (see Figure 8; character 81) and an eyelet (see Figure 7; character 76) allowing said cleat(s) to firmly attach on said second part of said two-part IOL (see column 5, lines 19-22; column 6, lines 43-50; column 7, lines 34-60; see entire document).

12. Claims 40, 41, and 46-76 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Brady et al. (US 5,201,763 A). Brady et al. disclose a two-part IOL with a deformable refractive optic made of silicone and haptics made of PMMA. As seen in Figure 1, the proximal end of the haptics is formed as a loop (character 31). This loop is attached to the peripheral zone

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of the optic (at the radial projections or buttresses 33; see column 6, lines 9-32). The optic is to be folded for implantation in the eye (see column 2, lines 50-53; column 3, lines 24-35 and lines 64-68; column 4, lines 46-49; column 5, lines 39-43; column 6, lines 6-16; Figures 1-2). Brady et al. disclose: "The thickness T2 of the peripheral zone 27 is no less than about 0.381 mm although thickness as small as about 0.305 mm can be employed." (see column 5, lines 51-54). From their Figure 2, it could be seen that the thickness of haptic 17 (higher modulus material) is a lot less than T2. Brady et al. disclose a lower modulus material (silicone) with tensile strength up to about 1000 psi and a Shore A hardness of about 38 (see column 5, lines 23-28). Brady et al. disclose that the lower modulus material partially covers the haptics (see column 3, lines 64-68; column 4, lines 3-8; column 6, lines 13-16; Figure 1). Brady et al. disclose that the material of the optic (lower modulus material) completely surrounds the attachment regions of the haptics (see column 6, lines 9-16). Brady et al. disclose an optic (made of silicone) and a haptic (made of PMMA) comprising a pair of stiff elements joined by a flexible element of different material (see column 2, lines 50-53; column 3, lines 24-35 and lines 64-68; column 4, lines 46-49; column 5, lines 39-43; column 6, lines 6-16; Figures 1-2).

13. Claims 40, 41, 46-52, 67, and 73 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hanna (FR 2 784 575 A1; cited in Applicant's IDS). As seen in Figures 1-5, Hanna clearly discloses the claimed attachment for a two-part IOL (see also entire document).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Poler (US 4,434,515 A), Neuhaus (US 6,413,277 B1), and Blake (US 6,425,917 B1).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:00 a.m.-4:30 p.m.), first Friday off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



JGB

October 9, 2002


David H. Willse
Primary Examiner